

### **III. Remarks**

#### **A. Introduction**

Reconsideration and allowance of the present application are respectfully requested. Claims 5-10, 15-18, and 20-25 are pending. Claims 5, 9, 15, and 21-25 have been amended. No claims have been cancelled or added. No new matter has been introduced.

The amendments to claims 5, 9, 15, 21-25, as well as the specification, is to clearly set forth the name of the compound of formula 1 on page 5 of the specification, namely a dialkylthiodipropionate and ditridecylthiodipropionate, and not a dialkyldithioproprionate and ditridecylthioproprionate, respectively.

#### **B. Claim Rejections under Section 112**

Claims 5-8, 15-18, 21, and 22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 5-8, 15-18, 21, and 22 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Independent claims 21 and 22 have been amended to obviate these rejections.

#### **C. Claim Rejections under Section 103(a)**

Claims 5-10, 15-18, and 20-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1,054,052 to Reyes-Gavilan, *et al.* (“Reyes-Gavilan”) in view of WO 2005/023886 to Wegmann, *et al.* (“Wegmann”). Applicants respectfully traverse this rejection for the reasons that follow.

#### **1. Wegmann Fails to Qualify under Section 102**

A prerequisite to a proper rejection under Section 103(a) is that each reference must qualify under at least one provision of Section 102. The Office Action has failed to identify any provision under Section 102 qualifying Wegmann as a citable reference. Wegmann is a published application of an international application that was filed on September 1, 2004, and which published on March 17, 2005. The international application was filed in Europe and designated the United States. The priority claim to EP20030102727, which was filed on

September 10, 2003, is not considered for purposes of Section 102(e). *See* MPEP § 706.02(f)(2) (“Foreign applications’ filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) or (b)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a) or (b).”) (emphasis in original). The present application was filed on February 3, 2004, well before the September 1, 2004 filing date of the Wegmann international application. Thus, the present application was filed before the filing and publication dates of Wegmann, and Wegmann **cannot** qualify under any provision of Section 102. Accordingly, Wegmann is not citable as a reference against the currently pending claims.

## **2. Office Actions Fails to Provide a Reference or Combination of References that Teach Every Claim Element.**

To reject a claim based on 35 U.S.C. § 103(a) all of the claim limitations must be taught or suggested by the cited references. *See In re Royka*, 490 F.2d 981, 985 (CCPA 1974).

Independent claim 9 recites a composition comprising “butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate....” Independent claims 21, 22 and 24 recite a similar feature. The Office Action has admitted that Reyes-Gavilan fails to teach butyl-3-(3,5-di-tert-butyl-4-hydroxyphenyl)propionate as claimed. (*See* Office Action, page 4). Further, the Office Action has failed to cite any other reference that qualifies under Section 102 for teaching this admitted deficiency of Reyes-Gavilan. Accordingly, Reyes-Gavilan does not teach every element as set forth in independent claims 9, 21, 22 and 24. Therefore, for at least this reason, independent claims 9, 21, 22 and 24 are patentable over Reyes-Gavilan and this rejection should be withdrawn.

## **3. Dependent Claims**

Dependent claims 10 and 23 contain all the limitations of independent claim 9 from which they depend and thus are patentable over the cited reference for at least the same reasons as independent claim 9. Dependent claims 5-8 contain all the limitations of independent claim

21 from which they depend and thus are patentable over the cited reference for at least the same reasons as independent claim 21. Dependent claims 15-18 contain all the limitations of independent claim 22 from which they depend and thus are patentable over the cited reference for at least the same reasons as independent claim 22. Dependent claims 20 and 25 contain all the limitations of independent claim 24 from which they depend and thus are patentable over the cited reference for at least the same reasons as independent claim 24.

**D. Conclusion**

In view of the above remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3536. All correspondence should continue to be directed to the below-listed address.

Respectfully submitted,

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